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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

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EXAMINER

CHEN, TE Y

ART UNIT PAPER NUMBER

2171

DATE MAILED: 06/03/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/520,264

Applicant(s)

Weaver et al.

Examiner

T. Chen

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 19, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 17 6) ☐ Other:

Art Unit: 2171

Response to Amendment

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/24/2003 has been entered.
2. This is in response to amendment filed on 03/24/2003 (paper # 17).
3. Claims 1-49 pending for examination, claims 1, 4-14, 17-21, 23, 28-30, 33, 43, 47 and 49 have been amended.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2171

5. Claims 1-8, 28-31, 46 and 49, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

6. As to claims 1, 4, 6-8, and 28, these amended claims contains new matter -- "storage system" which was not disclosed in the original specification, therefore, is not considered. Applicant is required to cancel the new matter in the reply to this office action.

7. As to claims 2-3, 5, 29-31, 46 and 49, these claims have the same defect as their base claims, hence are rejected for the same reason.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-8, 28-31, 46 and 49, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

Art Unit: 2171

application was filed, had possession of the claimed invention. For example, applicant's original specification fails to disclose "a storage system" as recited in every independent amended claim, which is an undue breadth. Since it enlarge the invention scope from a narrower "database system" to a broader "storage system" without disclosing the supporting technique, as how to handle different types of data storing technique for a storage system instead of the original cited database format. Therefore, all the independent amended claims are rejected.

10. As to claims 2-3, 5, 29-31, 46 and 49, these claims have the same defects as their base claims, hence were rejected for the same reason.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-49, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2171

13. As to claims 1, 13, 21, 23 and 43, try to avoid using the phrase “can be”, because these terms lead to uncertainty of whether anything actually occurs (or results).

14. As to claims 1, 4, 9, 13, 17, 20, 23, 28 and 43, it is not understood what is it meant by “the electronic files being previously communicated independently of and externally to a network portion having the server” [i.e., based on applicant’s specification, the examiner found that the claimed legal data processing system uses Internet protocol to communicate electronic legal documents in a client/server environment. Wherein the Internet protocol is handled by a plurality of network servers, it is not clear how the claimed data communication is able to be processed independently of and externally to a network portion having the server?]

15. As to the rest of dependent claims, since they inherent the same defects as their base claims, hence are rejected for the same reason.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 2171

17. Claims 1-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (U.S. Patent. No. 6,332,154).

18. As to claim 17, Beck et al. (hereinafter referred as Beck) disclosed a multimedia data processing apparatus having Internet communication protocol to communicate data between a plurality of clients / servers [Fig. 1]. The system comprising:

a server couple to a database system via a network [e.g., see the customer-interaction network operating system (CINOS) of Fig. 1; col. 8, line 54 - col. 9, line 17], wherein the database system receiving input from users via Web Form customer interface [e.g. see 133, Fig. 5], and generating indexed electronic documents and electronic characteristics of the documents format, such that the server will use the stored information to search for electronic documents matching user's query and provide search results to the user [col. 10, lines 16-20; col. 11, lines 13-25, lines 50-55; Fig. 4, Fig. 12 , Fig. 13].

19. As to claim 18, in addition to all features of claim 17, Back further disclosed that the server stores user-input information associated with representations of electronic documents [col. 10, lines 34-40; 287, Fig. 14; col. 34, lines 50-54].

Art Unit: 2171

20. As to claim 19, in addition to all features of claim 17, Back further disclosed that the electronic documents comprise E-mail messages having threading information [Fig. 8; col. 6, lines 53-56].

21. As to claim 20, Back disclosed the claimed system substantially comprising:
a conversion engine to convert electronic legal documents into a database format [col. 10, line 62 - col. 11, line 7; col. 22, lines 10-14]; and
a network server coupled to the conversion engine and communicatively coupled to a database system, wherein the server capable of using the indexing information and the electronic characteristics to provide search results to the user node in responsive to the search query [77, 79 Fig. 1; col. 10, lines 23-33; col. 11, lines 29-30; 51-53].

22. As to claims 21, 36-37 and 40-44, in addition to all features of claim 20, Back further disclosed that the system will load the electronic legal documents into database system, comprising:

recursive search engine to recursively extracting a plurality of electronic documents provided from a source [109, 113, Fig. 3; multimedia search engines, col. 50, lines 1-15];

controller coupled to the recursive engine to identify a plurality of objects having different data formats for each of the extracted electronic documents via the electronic characteristics [97, Fig. 3; Database Access Module (DAM), col. 28, lines 30-33];

Art Unit: 2171

an upload unit coupled to the controller to store data associated with the identified objects in a first location in the database system [col. 10, lines 51-59; col. 55, lines 19-33];

a converter to convert the other identified objects and storing data associated with the converted objects in a second location in the database system [253, Fig. 12; col. 10, lines 23-31];
and

the data stored in the first and second locations are indexed [col. 11, lines 51-53] .

23. As to claim 22, in addition to all features of claim 20, Back further disclosed that a first server unit to store indexing information associated with text context of the electronic documents [79, Fig. 1; 75, Fig.1]; and a second server unit to store indexing information associated with metadata content of the electronic documents [57, Fig. 1; 275, Fig. 12].

24. As to claims 33, 35 and 45, in addition to the features disclosed above, Back further disclosed that the electronic documents comprise electronic legal documents [col. 22, lines 12-14].

25. As to claims 23-30 and 48-49, these claims recited the same limitations as claims 17-22, 33 and 35-45, in form of machine-readable medium product or network node, hence were rejected for the same reasons.

Art Unit: 2171

26. As to claims 1-16, 31-32, 34 and 46-47, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure of claims 17-30, 33, 35-45 and 48-49, in the combination discussed above, hence were rejected for the same reasons.

Response to Arguments

27. Applicant's arguments filed on 03/24/2003 have been fully considered but they are not persuasive.

28. Regarding Applicant's arguments with respect to the 112 rejections, the examiner disagrees with applicant's assertion that the amended claims 1, 13, 20, 23, and 43, with citation of "the electronic files can be subject to a legal proceeding" would overcome the rejection. Because the use of phrase "can be" renders the claimed limitation indefinite as discussed above.

29. Regarding Applicant's arguments with respect to the 102 rejections, the examiner disagrees with applicant's assertion that the prior art on record including Beck, fails to disclose or suggest: "the electronic documents were previously communicated between parties independently of and externally to the network portion having the server". As discussed in the above U.S. Code 112, second paragraph rejection, the examiner specifically points out that the claimed feature is unclear. For example, as disclosed by Fig. 1 of current application, all the electronic documents were communicated via Internet protocol, wherein, the Internet protocol is

Art Unit: 2171

obviously communicate to the server 112 of the network, as such, it is not clear how the electronic documents were be able to previously communicated between parties independently of and externally to the network portion having the server. Furthermore, Beck specifically discloses a plurality of networks (for example, the PSTN 13 and WAN 15, Fig. 1], these networks coupled to a plurality of TS servers (e.g., 22, 63, 73, Fig. 1), which are separated from the MIS server (79, Fig. 1), and is able to perform previous electronic document communication [e.g., e-mail, voice response, facsimile, video downloading, etc., col. 6, lines 5-8] between parties independently of and externally from the IMS servers. Thus, the examiner maintains the original rejection.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.


31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are: (703) 746-7238 (After Final Communication); (703) 746-7239 (Official Communications); and (703) 746-7240 (For Status Inquiries, Draft Communication).

Art Unit: 2171

32. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

May 30, 2003


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